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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/064,221	06/21/2002	Lawrence Miller	36287-03500	4472

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EXAMINER	
SWEARINGEN, JEFFREY R	

ART UNIT	PAPER NUMBER
2145	

DATE MAILED: 05/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/064,221	MILLER ET AL.	
	Examiner	Art Unit	
	Jeffrey R. Swearingen	2145	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 February 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 and 11-25* is/are pending in the application.

4a) Of the above claim(s) *2-10* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 and 11-25* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *2/27/06* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. The objection to the drawings is withdrawn.

2. The rejection under 35 U.S.C. 112, first paragraph is maintained. Applicant cited paragraphs [0042]-[0044] of the specification to allegedly support the language of including a token [cookie] in the request from the client to the server. Applicant amended the claims to state the connection request comprises a link. The specification is silent on how a link can contain a cookie within it, or how a request can include a cookie in it. Apparently the client somehow sends a link and a cookie to a server, which receives said link and said cookie and sends them back to the client. If this is not Applicant's intention of the invention, then Applicant must appropriately claim the invention within the guidelines of matter supported by the original specification. If in fact Applicant is including a cookie and a link within a request, Applicant must provide evidence in the originally filed specification that would allow one of ordinary skill in the art to implement such a request containing a link and a token.

3. The double patenting rejection with copending Application 10/064,118 is maintained. Claim 1 of the instant application is a broader reading of claim 1 in the copending application, and therefore is an obvious variant. Claim 1 of the copending application, however, is not an obvious variant of claim 1 of the instant application; the double patenting is one-way obviousness.

4. Applicant's arguments are directed toward the amended claims, which are herein treated.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1 and 18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. A key element of claims 1

and 18 is the phrase *determining whether the request includes a token* [cookie]. Upon careful consideration of the specification, no portion of the specification can be located that deals with including a *token* [cookie] in the request from the client to the server. It is unknown why the client would be transmitting a *token* [cookie] to the server when the invention instead seems to be directed to retrieving said *token* [cookie] from said server.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., In re Berg, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1 and 18 are provisionally rejected on the ground of nonstatutory double patenting over claim 1 of copending Application No. 10/064,118. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows:

Application 10/064,221 is in *italics*. Application 10/064,118 is in **bold**.

Claim 1: *A method for providing information to a client browser* (**A method for providing information to a client browser**), *the method comprising: sending a connection request from a client to*

a server, wherein the connection request comprises a link (**receiving a first request from a client at a server**)*; determining at the server whether the connection request includes a token* (**responsive to the first request, initiating a request by the server to create a token, wherein the token comprises a request by the client for a resource**)*; and determining whether the token is available to send to the client, wherein the token is created responsive to an earlier request from the client to the server; sending the link to the client based at least in part on whether the token is available, wherein the token serves to authenticate or authorize one or more subsequent resource requests by the client.* (**receiving a second request from the client at the first link; determining in response to the second request whether the token has been retrieved; and sending the token to the client if the token has been retrieved**).

Claim 1 of the instant application is a broader recitation of claim 1 in the copending application, and the substance of the claims is equivalent. Claim 1 in the copending application has additional steps not listed in claim 1 of the instant application; claim 1 of the instant application is therefore an obvious variant of claim 1 in the copending application since it is a broader and simpler version of the claimed invention.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

10. Claims 1 and 11-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Ballard (US 6,449,765 B1).

11. In regard to claims 1 and 18, Ballard disclosed

sending a connection request from a client to a server, wherein the connection request comprises a link; (column 9, lines 19-43)

determining at the server whether the connection request includes a token; (column 9, lines 19-43) *and*

determining whether the token is available to send to the client, wherein the token is created responsive to an earlier request from the client to the server; (column 9, lines 19-43)

sending the link to the client based at least in part on whether the token is available, wherein the token serves to authenticate or authorize one or more subsequent resource requests by the client. (column 9, lines 19-43)

12. In regard to claims 11 and 19, Ballard disclosed

determining that the connection request includes the token; (column 9, lines 19-43)

making a record of the token in a storage mechanism; and (column 9, line 35)

sending the link to the client without the token. (column 9, lines 19-43)

13. In regard to claims 12 and 20, Ballard disclosed

the storage mechanism is one of a buffer and a database. It is inherent that a buffer or database was used to store information about the end users in Ballard since the users signed up for access.

14. In regard to claims 13 and 21, Ballard disclosed

determining that the connection request does not comprise the token. (column 9, lines 19-43)

15. In regard to claims 14 and 22, Ballard disclosed

determining that the token is available for transmission to the client; (column 9, lines 19-43)

processing the token with the requested link; and (column 9, lines 19-43)

sending the link with the token to the client. (column 9, lines 19-43)

16. In regard to claims 15 and 23, Ballard disclosed

determining that the token is not available for transmission to the client. (column 9, lines 19-43)

17. In regard to claims 16 and 25, Ballard disclosed

determining that a timer has not expired; (A cookie inherently has an expiration time)

determining whether the token is available for transmission to the client; (column 9, lines 19-43)

sending the link to the client based on the whether the token is available. (column 9, lines 19-43)

18. In regard to claim 24, Ballard disclosed

the server determines that a timer has expired; (A cookie inherently has an expiration time)

and sends the link without the requested token to the client. (column 9, lines 19-43)

Conclusion

19. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey R. Swearingen whose telephone number is (571) 272-3921. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on 571-272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jason Cardone
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